



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,525	08/15/2001	Jochen Dietrich	435808600002	2418

7590 08/09/2004

Jones Day Reavis & Pogue
North Point
901 Lakeside Avenue
Cleveland, OH 44114

EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT	PAPER NUMBER
----------	--------------

1733

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/720,525

Applicant(s)

DIETRICH ET AL.

Examiner

Gladys J Piazza Corcoran

Art Unit

1733

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 97-116.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


Gladys JP Corcoran
Examiner
Art Unit: 1733

Continuation of 10. Other:

It is noted that the Amendment filed July 8, 2004 is non-compliant in that it does not indicate the status of claims 1-97, which are cancelled. Additionally, claim 110 is not properly underlined to show the newly added limitations.

It is further noted that if filed separately in a proper amendment, claims 117 and 118 would be allowable.

The Amendments to claims 109-112, 114-116, add new limitations that would require further search and consideration and raise the issue of new matter (as indicated in the Interview Summary on July 23, 2004).

Applicants arguments with respect to the 35 USC 112 enablement rejection in paragraph 4 of the previous Office Action filed April 28, 2004 are considered to be persuasive, consequently this rejection is withdrawn. However, the 35 USC 112 written description rejection in paragraph 3 of the previous Office Action is maintained.

As indicated in the Interview on July 23, 2004, there is no disclosure that indicates that one of ordinary skill in the art would have recognized that the Applicant was in possession of the method of forming a tray in a first mold and then attaching a collar to the tray in a second mold, different from the first. The disclosure in relation to figure 16, discloses forming a tray in a mold and also attaching a collar to the tray in the same mold. While, the disclosure in relation to figure 18 shows pre-fabricated trays that are placed in a mold to attach collars to the trays, there is no indication that Applicants were in possession of the method where the pre-fabricated trays were pre-fabricated in a mold. There are other ways known in the art of forming trays other than in a mold, including mere folding steps (it is noted that Applicant argues as such in relation to the Andersson patent).

Applicants arguments on page 11 that the original claims show support for erecting a tray in a mold are not persuasive. There is no support in the original claims of pre-fabricating a tray in a mold and then assembling the collar with the tray in a separate mold.

It appears as though Applicant in the second full paragraph on page 11 is arguing that one of skill in the art would recognize that a tray can be erected in a first mold and then assembled with a collar in another mold with the same configuration as the first mold. However, the written description requirement requires that original disclosure convey to one of ordinary skill in the art that the inventors had possession of all the claimed limitations.

As to Applicant's arguments that Andersson's tray is not capable of being erected in a mold, these arguments are unpersuasive. It is well known in the art to erect trays in molds, even trays with folds. For example, it is known to score blanks prior to placing in a mold. It is also known to provide fold lines in blanks prior to placing in a mold for final shaping. Additionally, it is known to press blanks into molds where folds are simultaneously formed in the blanks to form trays.